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Customer Number

Patent
Case No.: 58502US004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: JOSEPH, STEPHEN C.P.
Application No.: 10/551093 Confirmation No.: 1630
Filed: March 12, 2004 Group Art Unit:
Title: SPRAY GUN WITH ROTATABLE RESERVOIR

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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| October 2, 2009 | <i>Colleen M. Wagner</i> |
| Date | Signed by: Colleen M. Wagner |

Dear Sir:

In response to the final action dated June 5, 2009 and the Advisory Action dated September 14, 2009, and prior to filing an appeal brief, a Panel Review of the legal and factual basis of the rejections in the above-identified application is hereby requested. No amendments are being filed with this request. This Pre-Appeal Brief and Request for Review is being filed with a Notice of Appeal.

Fees

- ☒ Any required fee will be made at the time of submission via EFSWeb. In the event fees are not or cannot be paid at the time of EFS-Web submission, please charge any fees under 37 CFR § 1.17 which may be required to Deposit Account No. 13-3723.
- ☐ Please charge any fees under 37 CFR §§ 1.16 and 1.17 which may be required to Deposit Account No. 13-3723.
- ☒ Please charge any additional fees associated with the prosecution of this application to Deposit Account No. 13-3723. This authorization includes the fee for any necessary extension of time under 37 CFR § 1.136(a). To the extent any such extension should become necessary, it is hereby requested.
- ☒ Please credit any overpayment to the same deposit account.

REMARKS

Status of the Claims

The pending claims are claims 6–14. Claims 6, 13 and 14 stand rejected. Claims 7-12 were objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form.

Review is Requested for the Following Reasons

Claims 6, 13 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,875,971 (Moreck). The Patent Office has not established a legally sufficient case demonstrating that Applicants' claims are *prima facie* obvious in view of Moreck because the following elements required by Applicants' independent claim 6 are *not* disclosed by Moreck.

1. "Connector Means Connecting an Outlet from the Reservoir to the Inlet of the Spray Gun"

Applicants' "connector means" comprises "at least one resilient clip... engageable with an abutment." The Patent Office has equated Moreck's stop spring 33 with the resilient clip and Moreck's snap-in notches 32 with the abutment.¹ In Moreck, stop spring 33 is formed on housing part 18 and snap-in notches 32 are provided on housing part 17.² The Patent Office has equated housing part 17 with Applicants' reservoir.³ However, housing part 18 *cannot* be the inlet for Moreck's spray gun because "sealing elements are present to prevent foaming agent from entering the interior of housing part 18."⁴ The Patent Office previously acknowledged this stating that "housing part 18 has never been designated as the spray gun inlet."⁵ Thus, Moreck's stop spring 33 and snap-in notches 32 *cannot* "connect an outlet from the reservoir to the inlet of the spray gun."

2. A "Spring Leg [That] Can Rotate Relative to the Ledge"

Applicants' resilient clip comprises a "spring leg" and the abutment comprises a "ledge." The spring leg engages the ledge and can rotate relative to the ledge. The Patent Office has equated Moreck's stop spring 33 with the spring leg and snap-in notches 32 with the ledge.⁶ Stop spring 33 is formed on housing part 18 and snap-in notches 32 are provided on housing part 17.⁷

¹ See January 30, 2009 Office action (§2), June 5, 2009 Office action (§3), and September 14, 2009 Advisory Action (§11).

² Column 4, lines 20-28. See April 29, 2009 Response, pages 4-5, and August 24, 2009 Response, pages 4-5.

³ See September 14, 2009 Advisory Action (§11).

⁴ Column 5, lines 46-52.

⁵ See June 5, 2009 Office action (§5).

⁶ See January 30, 2009 Office action (§2) and June 5, 2009 Office action (§3).

⁷ Column 4, lines 20-28. See April 29, 2009 Response, pages 4-5, and August 24, 2009 Response, pages 4-5.

"Housing part 17 ... is adapted to be rotated ... relative to housing part 18."⁸ Thus, Morck's snap-in notches 32 (which are formed on housing part 17) rotate relative to stop spring 33 (which is formed on housing part 18.) *This is the opposite of what Applicants claim.*

3. "Reservoir Outlet and Spray Gun Inlet Connectable by Push Fit"

The Patent Office previously contended that this feature was found in Morck, but that was when a *different* element was regarded as the reservoir, *not* housing part 17.⁹ The Patent Office has not shown that Morck's housing part 17 (the element *now* equated to Applicants' reservoir) and Morck's spray gun inlet are connectable by a push fit. Morck does *not* disclose that these elements are connectable by a push fit.

4. "Connector Means Being Releasable for Detaching the Outlet From the Inlet"

The Patent Office previously contended that this feature was found in Morck, but that was when a *different* element was regarded as the reservoir having an outlet, *not* housing part 17.¹⁰ The Patent Office has not shown that Morck's stop spring 33 and snap-in notches 32 (the elements collectively associated with Applicants' "connector means") are releasable for detaching the outlet of housing part 17 (the element *now* equated to Applicants' reservoir) from Morck's spray gun inlet. Morck does *not* disclose that stop spring 33 and snap-in notches 32 are releasable for detaching the outlet of housing part 17 from the spray gun inlet.

Conclusion

Review and withdrawal of their rejections are respectfully requested. By setting forth the clear grounds of error, Applicants do not assert that these are the only errors that the Patent Office has made, nor do Applicants waive any arguments that may be asserted in an Appeal Brief.

Accordingly, Applicants reserve the right to present additional arguments in the Appeal Brief in relation to the independent and also the dependent claims.

⁸ Column 3, lines 58-61.

⁹ See January 30, 2009 Office action (§2) and June 5, 2009 Office action (§3) referring to Morck column 3, line 40 disclosure of "a pressure can for the medium (not shown)" as the reservoir.

¹⁰ *Id.*

Applicants respectfully request that the Panel review and reverse the final rejections of claims 6, 13 and 14 in the above-identified application and that a Panel Decision allowing the application on the existing claims be issued.

Respectfully submitted,

October 2, 2009
Date

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